

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q105981

Ryosuke NAKANO, et al.

Appln. No.: 10/575,253

Group Art Unit: 1633

Confirmation No.: 9644

Examiner: Kelaginamane T. HIRIYANNA

Filed: April 10, 2006

For: GENOMICALLY MODIFIED CELL NEUTRALIZED TO SERUM-FREE SYSTEM

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This responds to the Restriction and Election of Species Requirements, dated June 26, 2008.

In response to the Restriction Requirement, Applicants elect Group I, Claims 1-13 for examination. This election is made with traverse, for the following reasons.

Applicants note that in the Restriction Requirement, Claims 1-13 are grouped within Group I, and Claims 23, 24, 26 and 27 are grouped within Group IV. In setting forth the requirement, the Examiner appears to take the position that the claims of Group IV are distinct from the claims of Group I inasmuch as the claims of Group IV encompass a cell that is "naturalized," which Applicants understand to be a cell which is naturalized in a serum-free

medium. However, Applicants respectfully point out that the claims of Groups I and IV both recite knockout cells *naturalized* in a serum-free medium. For example, Claim 1 (of Group I) and Claim 23 (of Group IV) both recite “a cell in which a genomic gene encoding an enzyme relating to a sugar chain modification in which 1-position of fucose is bound to 6-position of N-acetylglucosamine in the reducing end through [alpha]-bond in a complex type N-glycoside-linked sugar chain is knocked out, wherein the cell is naturalized in a serum-free medium.”

(Emphasis added.)

Further, Applicants respectfully point out that the subject matter of Group IV is encompassed by the subject matter of Group I, in that the claims of Group IV further define the claimed cells of Claim 1 according to the process by which they are produced. Because product-by-process claims are examined with respect to the *product*, not the process used to arrive at the claimed product, the examination and searching required for Claim 1 (of Group I) would necessarily encompass examination and searching of the subject matter of Claims 23, 24, 26 and 27 (of Group IV). For this reason, Applicants respectfully submit that the examination of Groups I and IV does not constitute an undue burden. Accordingly, Applicants respectfully submit that Restriction between Groups I and IV is improper, and that the claims of Groups I and IV should be examined together.

In response to the Election of Species Requirement, Applicants elect α -1,6-fucosyltransferase as the species of genomic gene encoding an enzyme relating to sugar chain modification, without traverse. In response to the Examiner’s requirement that Applicants

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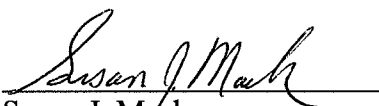
further elect a single SEQ ID NO which corresponds to the elected enzyme relating to sugar chain modification, Applicants elect SEQ ID NO: 5, without traverse.

Applicants submit that if any of the elected claims is found to be allowable, claims dependent therefrom should similarly be considered allowable in the same application.

Applicants reserve the right to file one or more Divisional Applications directed to non-elected subject matter.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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Date: September 26, 2008